

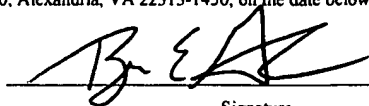
AP
DFW

CERTIFICATE OF MAILING
37 C.F.R. 1.8

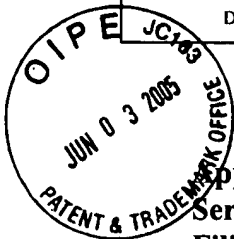
I hereby certify that this correspondence is being deposited with the U.S. Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date below:

May 31, 2005

Date



Signature



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Skillen et al.

Serial No: 09/351,747

Filing Date: July 8, 1999

Title: ASSOCIATIVE SEARCH ENGINE

Examiner: David Yiuk Jung

Art Group: 2134

Docket No: HQ0045A

Date: 5/31/05

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Applicants hereby file this Reply Brief in response to an Office Action mailed February 28, 2005, request reinstatement of the Appeal, and respectfully request consideration of the remarks presented herein. The three (3) month shortened statutory period for responding to the Office Action of February 28, 2005 is May 31, 2005 because May 28, 2005 fell on a Saturday and May 30, 2005 was a holiday (Memorial Day). Should the filing of this Reply Brief not be timely, the undersigned attorney hereby petitions for an appropriate extension of time and requests that the corresponding petition fee be withdrawn from deposit account No. 50-2126.

The format of this Appeal Brief complies with Rules of Practice Before the Board of Patent Appeals and Interferences (Final Rule), 69 Fed. Reg. 49959 (August 12, 2004), effective September 13, 2004.

1. Real Party in Interest: All rights to the above referenced patent application have been assigned to:

Nortel Networks Limited
2351 Boulevard Alfred-Nobel
St. Laurent, Quebec
Canada, H4S 2A9

2. Related Appeals and Interferences: There are no known other appeals or interferences that would directly or indirectly affect the Board's decision in the present appeal.

3. Status of the Claims: Claims 1-6, 9, 11-19, 75-79, 107, and 108 are pending. Claims 7, 8, 10, 20-74, 80-106, and 109-113 are cancelled.

Claims 1-6, 9, 11-19, 75-79, 107, and 108 stand rejected under 35 U.S.C. 103(a) as being unpatentable over EP 0749081A1, Pointcast Inc., ("Pointcast") and "The Search Engine Report," dated July 23, 1996 ("Sullivan"). These rejections were made in an Office Action mailed June 11, 2003 and reiterated in both the Final Office Action mailed April 6, 2004 and in the Office Action dated February 28, 2005.

4. Summary of Claimed Subject Matter:

Generally, the claims of the present application are directed to providing search results and advertisements to a user searching for desired information within a data network. Diagram 1 illustrates the elements of claim 1.

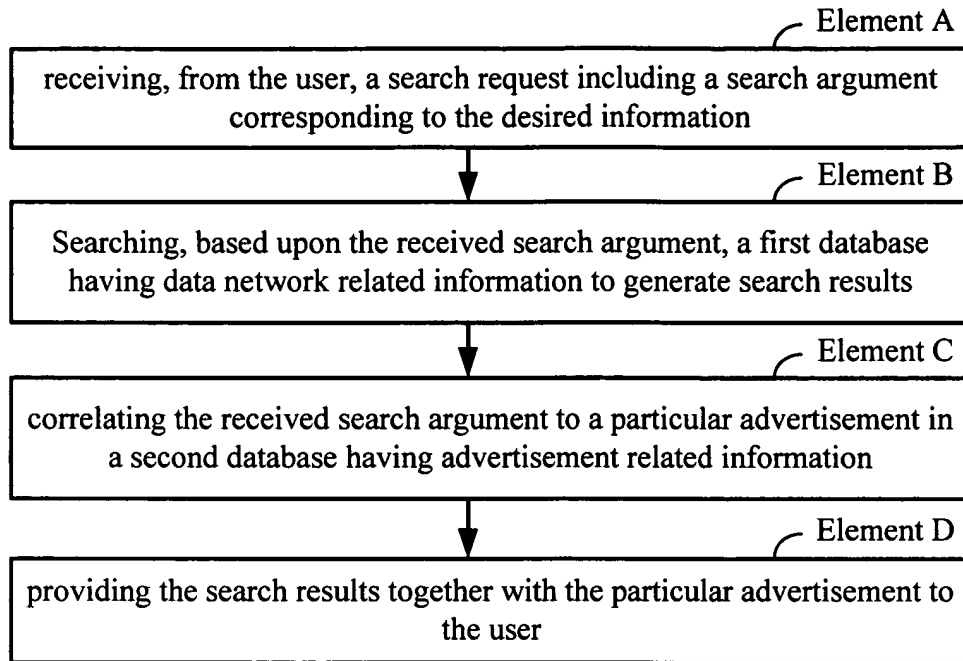


Diagram 1 - Elements of Claim 1

According to the elements of claim 1, operation commences with receiving, from the user, a search request including a search argument corresponding to the desired information (Element A). Operation continues with searching, based upon the received search argument, a first database having data network related information to generate search results (Element B). Operation continues with correlating the received search argument to a particular advertisement in a second database having advertisement related information (Element C). Operation concludes with providing the search results together with the particular advertisement to the user (Element D).

Independent claim 1 is a method claim that includes the operations of Diagram 1. Independent claim 9 is a system claim having means for performing the operations of Diagram 1. Independent claim 11 is a method claim requiring particular data network devices to perform the operations of Diagram 1. Independent claim 75 is a system claim directed to an advertising machine having elements that perform the operations of

Diagram 1. Claims 2-6, 12-19, and 76-79 depend from claims 1, 9, 11, and 75, respectively.

Independent claim 107 is a system claim directed to an advertising machine having elements that perform the operations of Diagram 1 and that alter their own operations based upon whether the advertisement was successful. Claim 108 depends from claim 107.

5. Grounds of Rejection to be Reviewed on Appeal: The applicants contend that claims 1-6, 9, 11-19, 75-79, 107, and 108 are not obvious under 35 U.S.C. 103(a) over Pointcast and Sullivan.

6. Argument:

The cited references are first discussed. Then, the Examiner's arguments are addressed.

The Pointcast Reference

Pointcast serves as the primary reference in the obviousness rejection. Diagram B illustrates generally the teachings of Pointcast.

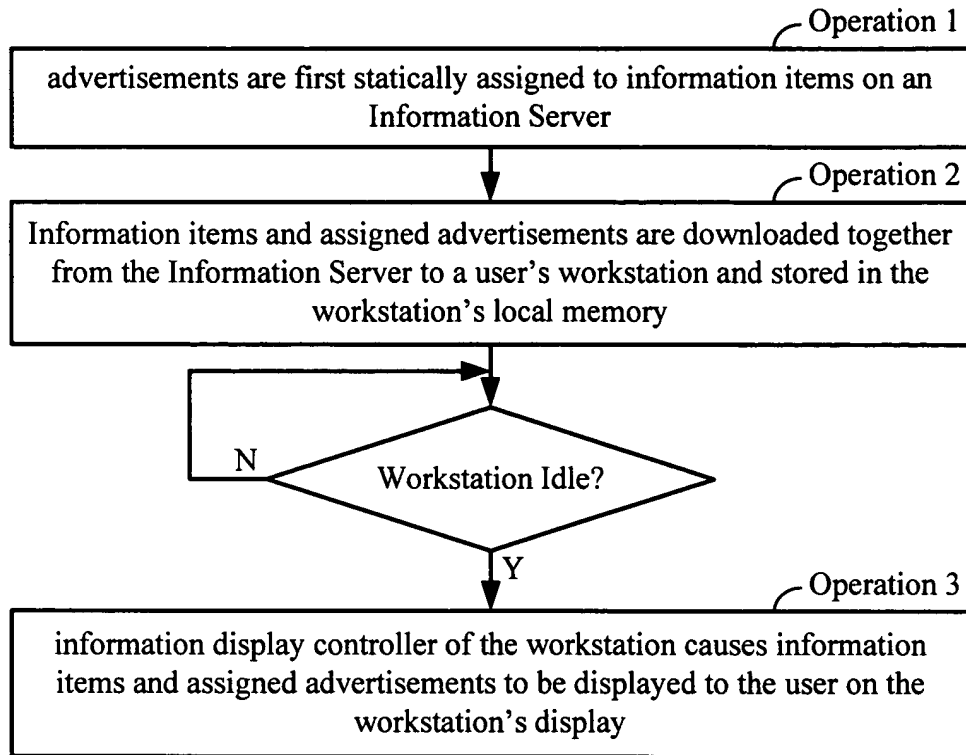


Diagram 2 - Teachings of Pointcast

Pointcast is directed to a system in which advertisements are first statically assigned to information items on an Information Server (Operation 1). The information items and assigned advertisements are then downloaded together from the Information Server to a user's workstation and stored in the workstation's local memory (Operation 2). When the workstation meets predefined idleness criteria, an information display controller of the workstation causes information items and assigned advertisements to be displayed to the user on the workstation's display (Operation 3). Subscriber profile data may be used to assist in selecting information items and assigned advertisements to be displayed. (Pointcast Abstract at page 1, Summary at page 3, and Description at pages 4-5). Pointcast therefore discloses a system that statically assigns advertisements to information items at an Information Server, periodically downloads information items

and assigned advertisements to the workstation, and then displays information items and assigned advertisements to the user on the workstation when the workstation is idle.

The Sullivan Reference

The Sullivan Reference is a trade publication that discusses then current issues relating to Search Engines (July 23, 1996). The Sullivan reference discloses that, as of July 23, 1996, controversy regarding the “sale of keywords” existed. (Sullivan page 1 of 3) Sullivan does not disclose, teach, or suggest what the “sale of keywords” involves. Sullivan only describes that the “sale of keywords” was controversial as of July 23, 1996. As such, Sullivan cannot even be cited to disclose, teach, or suggest what is involved in the “sale of keywords.”

At the bottom of page 1 of three and continuing to the top of page 2 or 3, Pointcast discloses that: “Open Text sells keywords: For \$2,000 and up, you can have your site appear in the top listings for six months on Open Text. Open Text is the first search engine to do this, caused some controversy.” While this practice is common today, as of July 23, 1996 this practice was relatively new and, according to Sullivan, controversial. Drawing C illustrates operations that are generally described by Sullivan relating to the “sale of keywords.”

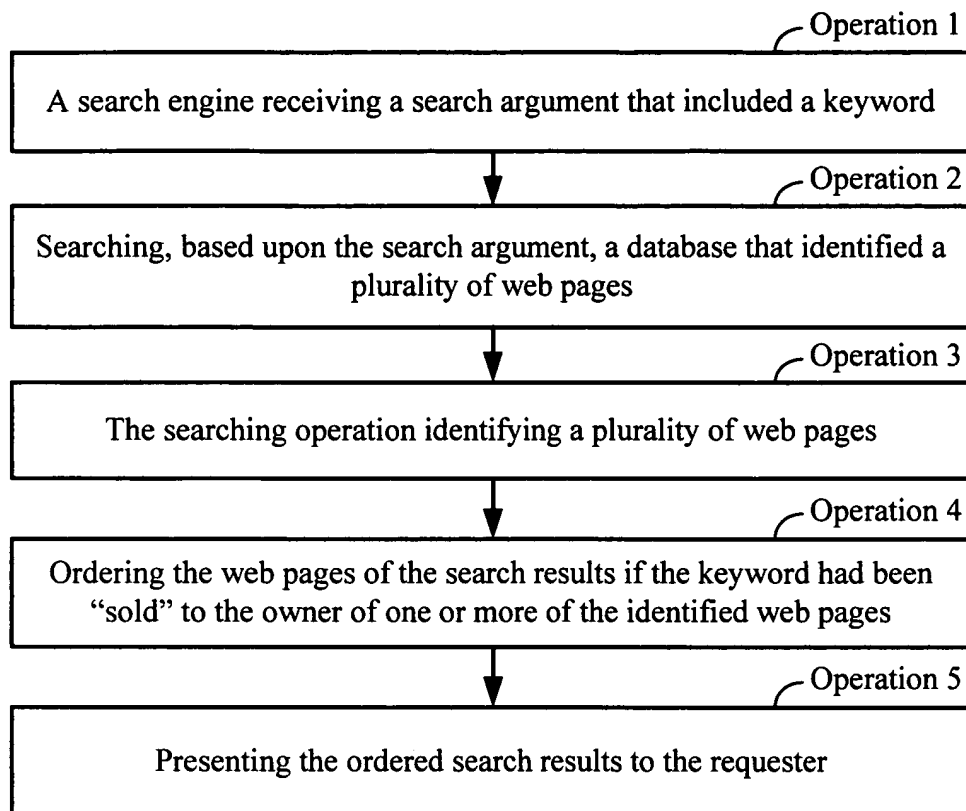


Diagram 3 - Keyword Selling as of 1996

As illustrated in Diagram 3, Operations 1, 2 and 3 are conventional search engine operations in which search results are produced in response to a search argument. However, with the "sale of a keyword", the search results were ordered based upon the "sold" keyword (Operation 4) and are the search results were delivered to the search requester in the determined order (Operation 5). These operations certainly do not disclose, teach, or suggest Elements C and D of claim 1.

The Google Reference

Cited in the Office Action of February 28, 2005, is a web page dated February 20, 2005. This article describes generally the history of Google, Inc., which was formally founded on September 7, 1998 (more than one year after the effective filing date of the

pending application, February 13, 1997). According to the Examiner, this reference is cited not as prior art but to “illustrate a typical use of search engine (then and now). This gives a typical use of search engines (then and now).” Office Action of February 28, 2005 at page 2.

Applicants respectfully disagree with this characterization of the state of the art as of the effective filing date of the present application. As stated in the cited article, “[i]n 2000, Google had begun selling advertisements by the keyword so that they would be more relevant to the end user.” Thus, not until 2000 did Google begin selling advertisements by the keyword, three years after the effective filing date of the present application. A timeline for Google, located at the URL address: <http://www.google.com/intl/en/corporate/timeline.html> states that not until 1998 was the Google search engine even in the beta stage, one year after the effective filing date of the present application.

In short, the Examiner cites the Google article in an attempt to equivalence the “selling advertisements by the keyword,” as now performed by Google, with the “selling of keywords” as mentioned in the Pointcast reference. However, the “selling of keywords” differs from “selling advertisements by the keyword.” With the “selling of advertisements by the keyword,” a search engine chooses advertisements based upon a sold keyword. Alternately, with the “selling of keywords,” search results are ordered based upon a sold keyword.

Pointcast and Sullivan do not render claims 1-6, 9, 11-19, and 75-79 obvious.

To establish a *prima facie* case of obviousness, three basic criteria must be met. “First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.” *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). MPEP § 2142, p. 2100-128 (Rev. 2, May 2004).

Claim 1 requires: (a) receiving, from a user, a search request including a search argument corresponding to the desired information; (b) searching, based upon the received search argument, a first database having data network related information to generate search results; (c) correlating the received search argument to a particular advertisement in a second database having advertisement related information; and (d) providing the search results together with the particular advertisement to the user.

The Examiner argues that Pointcast (at Page 9, Table 1) discloses: “receiving, from the user, a search request including a search argument corresponding to the desired information”. Table 1 of Pointcast is directed to the operation of a screen saver. The operations of Table 1 have NOTHING to do with the receipt of a search request from a user. As described in Pointcast at page 8 line 50, the procedures of Table 1 are invoked when NO USER INPUT is received, quite different than “receiving, from the user, a search request including a search argument corresponding to the desired information”.

The Examiner argues that Pointcast (at Page 9, Table 1) discloses: “searching, based upon the received search argument, a first database having data network related information to generate search results.” This portion of Pointcast is directed to the operation of a Screen Saver that displays information items and assigned advertisements upon a determination of user inactivity. Pointcast does not disclose, suggest, or teach searching of a database based upon a received search argument.

The Examiner argues that Pointcast (at Page 12, Table 2) discloses: “correlating the received search argument to a particular advertisement in a second database having advertisement related information.” This portion of Pointcast is directed to the update of the database of a workstation with new information items and advertisements. This portion of Pointcast does NOT disclose, suggest, or teach correlating the received search argument to a particular advertisement in a second database having advertisement related information as required by the claim element at issue.

The Examiner argues that Pointcast (at Page 12, Table 2) discloses “providing the search results together with the particular advertisement to the user”. Table 2 of Pointcast is directed primarily to the update of the database of a workstation with new information items and advertisements. While Pointcast does disclose providing information items and advertisements to a user, Pointcast does not disclose providing search results to a user. Pointcast discloses providing content and advertisements to a user that were downloaded in bulk from an Information server and then displayed upon user inactivity.

With regard to Sullivan, the Examiner argues that "selling of keywords" is equivalent to “correlating the received search argument to a particular advertisement in a second database having advertisement related information”. As described above with

reference to Pointcast and the Google article, “the sale of keywords” affects how search results are presented to a user, i.e., ordering search results based upon the “sold” keywords. In no way does Sullivan describe correlating a search argument to a particular advertisement in a second database search as required by claim 1 of the present application.

Independent claim 9 is a system claim having means for performing the operations described with reference to claim 1. Independent claim 11 is a method claim requiring particular data network devices for performing the operations described with reference to claim 1. Independent claim 75 is a system claim directed to an advertising machine having elements that perform the operations described with reference to claim 1. Claims 2-6, 12-19, and 76-79 depend from claims 1, 9, 11, and 75, respectively. For these reasons, Pointcast and Sullivan do not render claims 1-6, 9, 11-19, and 75-79 obvious.

Pointcast and Sullivan do not render claims 107 and 108 obvious.

Claim 107 is a system claim directed to an advertising machine. The advertising machine includes limitations of claim 75 and includes limitations requiring: (1) whether the advertisement (provided to the user) was successful; and (2) altering subsequent correlations of received search arguments to the second database. Claim 108 depends from claim 107 and includes additional limitations regarding the use of user profile data for the correlation.

As described above, Pointcast and Sullivan fail to render obvious claim 75. For this reason, Pointcast and Sullivan fail to render obvious claim 107. Further, claim 107

includes the additional above-described additional limitations that are also not disclosed, suggested, or taught by Pointcast and/or Sullivan.

Conclusion:

For the above-provided reasons, the Appellants respectfully request that the foregoing rejections be overturned and that the claims in the present application be allowed to issue.

RESPECTFULLY SUBMITTED,

By: 

Bruce E. Garlick
Registration No. 36,520
Phone: (512) 264-8816
Fax No. (512) 264-3735

Copy of Claims

1. (original) A method of providing advertisements to a user searching for desired information within a data network, comprising the steps of:

receiving, from the user, a search request including a search argument corresponding to the desired information;

searching, based upon the received search argument, a first database having data network related information to generate search results;

correlating the received search argument to a particular advertisement in a second database having advertisement related information; and

providing the search results together with the particular advertisement to the user.

2. (original) A method as claimed in claim 1, wherein the step of correlating the received search argument to the particular advertisement including selecting the particular advertisement based on the received search argument and user profile data.

3. (original) A method as claimed in claim 2, wherein the user profile data includes selections of the user from previous search arguments.

4. (original) A method as claimed in claim 3, wherein the user profile data includes selections of the user from previous search results.

5. (original) A method as claimed in claim 4, wherein the user profile data includes user specified preferences.

6. (original) A method as claimed in claim 1, wherein the step of providing the search results and the particular advertisement to the user includes displaying the search results as a page on a data processing device and the particular advertisement as an insert on the page.

Claims 7 - 8. (cancelled)

9. (original) A system for providing advertisements to a user searching for desired information within a data network, comprising:

means for receiving, from the user a search request including a search argument corresponding to the desired information;

means for searching, based upon the received search argument, a first database having data network related information to generate search results;

means for correlating the received search argument to a particular advertisement in a second database having advertisement related information; and

means for providing the search results together with the particular advertisement to the user.

10. (cancelled)

11. (original) A method of providing advertisements to a user searching for desired information within a data network, comprising the steps of:

receiving, at a server, a search request sent from a user, the search request including a search argument corresponding to the desired information;

searching, by the server computer based upon the received search argument, a first database to generate search results, the first database having data network related information and being contained on the server computer;

correlating the received search argument to a particular advertisement in a second database having advertisement related information, the second database contained on a client computer; and

providing the search results together with the particular advertisement to the user.

12. (original) A method as claimed in claim 11, wherein the step of correlating the received search argument to the particular advertisement includes selecting the particular advertisement based on the received search argument and user profile data.

13. (original) A method as claimed in claim 12, wherein the user profile data is based partially upon previous search arguments of the user.

14. (original) A method as claimed in claim 13, wherein the user profile data is based partially upon previous search results for the user.

15. (original) A method as claimed in claim 14, wherein the user profile data includes user specified preferences.

16. (original) A method as claimed in claim 11, wherein the step of providing the search results and the particular advertisement to the user includes displaying the search results as a page on a data processing device and the particular advertisement as an insert on the page.

17. (original) A method as claimed in claim 11, wherein the step of correlating the received search argument to a particular advertisement in the second database is performed by the client computer.

18. (original) A method as claimed in claim 11, wherein:
the server computer is a database search engine computer; and
the client computer is an access provider computer.

19. (original) A method as claimed in claim 11, wherein:
the server computer is a database search engine computer; and
the client computer is an associate search engine computer.

Claims 20 - 74 (cancelled)

75. (original) An advertising machine for providing advertisements to a user searching for desired information within a data network, the advertising machine comprising:

a server computer coupled to the data network that receives a search request from the user, the search request including a search argument corresponding to the desired information;

a database search engine coupled to the server computer that receives the search argument from the server computer and searches a first database to generate search results, the first database having data network related information and being contained on the server computer;

an associative search engine coupled to the server computer that correlates the received search argument to a particular advertisement in a second database having advertisement related information, the second database contained on a client computer; and

the server computer providing the search results together with the particular advertisement to the user.

76. (original) The advertising machine of claim 75, wherein the associative search engine selects the particular advertisement based on the received search argument and user profile data.

77. (original) The advertising machine of claim 76, wherein the user profile data is based partially upon previous search arguments of the user.

78. (original) The advertising machine of claim 76, wherein the user profile data is based partially upon previous search results for the user.

79. (original) The advertising machine of claim 76, wherein the user profile data includes user specified preferences.

Claims 80-106 (canceled)

107. (original) An advertising machine coupled to a data network for providing advertisements to a user, the advertising machine comprising:

a server computer coupled to the data network that receives a search request from the user, the search request including a search argument corresponding to the desired information;

a database search engine coupled to the server computer that receives the search argument from the server computer and searches a first database to generate search results, the first database having data network related information and being contained on the server computer;

an associative search engine coupled to the server computer that correlates the received search argument to a particular advertisement in a second database having advertisement related information, the second database contained on a client computer;

the server computer providing the search results together with the particular advertisement to the user;

the server computer determining whether the advertisement was successful; and

the server computer altering criteria for subsequent correlations of received search arguments to the second database.

108. (original) The advertising machine of claim 107, wherein the associative search engine correlates the received search argument to the particular advertisement based on the received search argument and user profile data.

Claims 109 - 113 (cancelled)